

Rejection of claims 1, 17, 23-24 and 33 under 35 USC §102(e)

The Office Action rejected claims 1, 17, 23-24, and 33 as being unpatentable under 35 USC §102(e) in view of Ferstenberg et al. (USP 5,873,071). Applicant respectfully traverses this rejection for the following reasons.

Applicant believes that a feature of the instant disclosure presents a novel and nonobvious method to devise a marketplace for certain property interests that are not currently available for purchase or sale. These include, but are not limited to, sale in *intangible property interests such as chattel paper, various kinds of rights, obligations, and intellectual property (e.g., patents, trademarks, trade secrets, and copyrights), and several derived property interests*. See Disclosure.

Ferstenberg, on the other hand, uses the word "intangibles" but defines these as *"intangibles, such as securities (stocks, bonds, and options) commodity futures, collateralized mortgage obligations, and pollution rights, as well as tangibles, such as copper or soy beans."* See Ferstenberg at Background of the Invention [Emphasis supplied]. Accordingly, Applicant believes that the subject matter described in Ferstenberg and the instant disclosure are not the same. In fact, in the section entitled "Background" Applicant distinguished the described property interests, which form the subject matter of the instant invention from those described by Ferstenberg.

In section 5.3, Ferstenberg et al. state that their invention was "particularly adapted to the exchange of financial commodities, and in this section the preferred implementation adapted to this exchange is described. Financial commodities include such intangibles as stocks and bonds, as well as contracts for the future exchange of tangible or intangible commodities, known as options. Preferably, these commodities are traded in financial markets during which publicly available bid and ask prices are established."

Nowhere does Ferstenberg allude to the type of subject matter described in the Applicant's disclosure. Applicant respectfully requests the Examiner to

reconsider in view that the mere usage of the word "intangible" in the Applicant's disclosure and the cited art does not indicate that the Applicant and Ferstenberg discussed the same subject matter. Clearly, the same word was used to mean different things.

Ferstenberg et al. describe their invention to be an intermediated exchange of commodities, and further, "a computer system (a computer-based machine including hardware and software) for *intermediated exchange that is capable of facilitating exchanges of multiple commodities for multiple participants according to their goals.*" See Summary of the Invention. [Emphasis supplied]. Ferstenberg is directed toward a "negotiation protocol specifies how to search through possible combinations of exchanges between participants in order to identify the combination that balances the goals of the intermediary with the goals of the participants in the exchange. The protocol addresses both the determination of which commodities are exchanged among participants and the amount of each commodity exchanged. It also provides a solution for the competitive equilibrium problem as it is applied to intermediated exchanges. A computer program constructed according to this protocol, together with accompanying hardware, permits participants electronically and automatically to carry out negotiations for the transfer of commodities through an intermediary." See Summary. This is clearly not the essence of Applicant's disclosure.

In view that Applicant's invention and Ferstenberg are directed toward different subject matter, Applicant believes that Ferstenberg does not anticipate or render obvious the instantly claimed invention. Accordingly, Applicant respectfully requests reconsideration and a withdrawal of this rejection.

Rejection of claims under 35 USC 103(a)

With the exception of claim 39, the Office Action rejected all other claims as being unpatentable under 35 USC §103(a) as being obvious over Ferstenberg et al. in view of Brett et al., Crain's New York Business, Dictionary of Finance and

Investment, Stallaert et al., or Harrington et al. Because Ferstenberg does not contemplate the subject matter of the instant invention, and therefore Ferstenberg does not present relevant art, Applicant believes that a combination of Ferstenberg with other art as cited in the Office Action does not render obvious any of the rejected claims. Regarding claim 39, Harrington does not contemplate the subject matter of the instant disclosure and therefore, it could not, in combination with other art, render the instantly claimed invention obvious. Reconsideration is requested.

Pursuant to M.P.E.P. §2136.05, at a later date, Applicant may furnish information that could antedate the instant invention compared to that of Ferstenberg et al.

#### Conclusion

This response addresses all grounds for rejection of claims in the Office Action. In view of the aforementioned arguments, applicant believes that all currently pending claims in the instant are patentable over the cited art. Reconsideration is respectfully solicited.

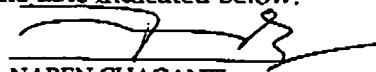
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#### Certificate of Faxing

I certify that this paper (together with any other papers mentioned or referenced herein as being enclosed herewith) is faxed to the United States Postal Service at the fax number (703) 746-7239, [the fax number listed for TC2100 on the web site <http://www.uspto.gov/september11/faxnotice.htm>] on the date indicated below.

April 29, 2002  
Date

  
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